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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/878,908	06/19/1997	KARL-LUTZ LAUTERJUNG	VAS.0002US	8837

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EXAMINER

PREBILIC, PAUL B

ART UNIT	PAPER NUMBER
3738	

3738

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/02/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No. 08/878,908	Applicant(s) LAUTERJUNG, KARL-LUTZ	
Examiner Paul B. Prebilic	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 13 November 2006.
- 2a) This action is **FINAL**.
- 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 32,65-73,75-79,81 and 82 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 32,65-73,75-79,81 and 82 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 32 and 75-79 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. For example, in claim 32, on lines 9-11, the language "substantially continuous contact with a surface of another winding for a complete turn of the given winding" lacks original support from the specification. A Request for Continued Examination does not provide for the introduction of new matter as does Rule 53 continuation-in-part applications.

In the response dated July 7, 2006, the Applicant provided what was supposed to be evidence of original support for the claims as amended on the same day; see page 10 of that communication. However, this evidence is not particularly directed to the language of the claim and it merely provides places where support can generally be found in the original specification. Prior to the previous Office action, the Examiner reviewed the citations could not find support for some of the claim language. The same holds true with respect to the present claim language. In particular, Figures 1, 8, and 10, as mentioned by Applicant as providing support, only show a small portion of the whole ring; see Figure 8 in particular. Further, these figures are merely sketches so that

lack the clarity and precision of a photograph or drawings drawn to scale. Furthermore, Figure 10 shows gaps between the windings where there is not contact between adjacent windings indicating that there is no support for continuous contact of one winding with another winding as now claimed. Moreover, it would be nearly impossible to have a winding in contact with another winding for a full turn especially if the winding was loosely held together as shown in Figure 10. Therefore, the Examiner reasons that the claim language does not have original support.

Claims 67-69 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 67, on lines 7-10, "said cross-section to be taken at any radial location of said element . . . said cross section is substantially the same" lacks original support in that it is not stated in the specification and cannot be said to be inherent thereto. In particular, Figures 8 and 10, mentioned by Applicant as providing support for this language, only shows a small portion of the entire ring and one cross-section thereof.

Claim Objections

Claim 75 is objected to because of the following informalities:

The language of the claim is confusing in that the language 'contact with another winding may not be with the same another winding' appears contradictory. Appropriate correction is required.

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Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 32 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 58 of copending Application No. 10832,159. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 58 appears to be read on by copending claim 32 such that it is considered clearly obvious in view thereof.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 65 and 66 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 48 of copending Application No. 10/835,159. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 65 and 66 are read on by claim 48 such that they are clearly obvious in view thereof.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 69 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 7 of copending Application No. 10/832,159. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 69 is read on by claim 7 such that it is clearly obvious in view thereof.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Upon review of the copending related application list provided by the Applicant on pages 11 and 12 of the November 13, 2006 response, the Examiner determined that claim 32 of the present application conflicts with claims 11 and 12 of copending application 11/496,162. The second section of claim 32 is equivalent to the first prosthesis of claims 11 and 12, the third prosthesis of claim 32 is equivalent to the second prosthesis of claims 11 and 12 and the fourth prosthesis corresponds to the third prosthesis of claim 12. However, in order to advance prosecution, a double patenting rejection will not be given at this time.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 67, 68, 70-73, 75-79, and 81-82 are rejected under 35 U.S.C. 102(e) as being anticipated by Dwyer et al (US 5,843,167). Dwyer anticipates the claim language where the diameter of at least one winding as claimed is that of 6 windings that are on opposite sides of the anchor (14R) see Figure 35; see the abstract and figures. Figures 35-38 illustrate merely the anchor portion of the implant where radially overlapping windings of wire form part of the resilient elements (anchors) of Dwyer. The anchors of Figures 35-38 are used as part of the distal anchor (14R); see Figures 35-38 and column 16, lines 36-59. The terminology "radially overlapping" is along the radius of the wire of the winding not the radius of the winding.

Claims 65, 66, and 69 are rejected under 35 U.S.C. 102(e) as being anticipated by Sigwart (US 5,443,500) as evidenced by Porier (US 4,118,806). Sigwart anticipates the claim language where the ring as claimed is the rolled sheet (1) of Sigwart, and the graft as claimed is the balloon (6) and catheter (7) of Sigwart (see Figure 1a and column 3, lines 6-20) made of a metal (see column 4, lines 47-50). The catheter and balloon of Sigwart is a graft to the extent that this term can be given patentable weight because grafts can have all the properties of catheters and be rigid. Porier et al (US 4,118,806) is evidence that grafts can be rigid and thus have all the properties that catheters could be said to have; see the abstract. For this reason, the graft as claimed is construed as being met by the balloon catheter of Sigwart.

Response to Arguments

Applicant's arguments filed November 13, 2006 have been fully considered but they are not persuasive.

In response to the argument that there is no evidence or reasoning provided for the Section 112, first paragraphs rejections, the Examiner asserts that he implicitly relied upon the evidence provided by the Applicant on July 7, 2006 in that the action was a response to Applicant response. The Examiner could have incorporated that evidence, but admittedly failed to do so. Therefore, the Examiner has provided a fuller explanation in the rejection as it is regiven in this Office action.

With regard to the prior art rejections, the Examiner asserts that the claim language is still read on by Dwyer when read more broadly than Applicant has interpreted it. In particular, the type of diameter of the windings is not specified and it can be taken across a plurality of windings on opposite sides of the ring.

With regard to the traversal of claim 70, the Applicant assumes that the device must be positioned in the same manner as that disclosed in the specification to meet the claim language. However, when the Dwyer stent-graft is placed entirely past the intersection except for the bends extending beyond the graft, then the claimed intended use functional language is fully met.

With regard to claim 75, the diametrical axis can be taken with the graft portion of the Dwyer ring such that each fold of the axis is in contact with graft.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Prebilic
Primary Examiner
Art Unit 3738